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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	H	ATTORNEY DOCKET NO.
087811, 234	03/03/97	SUGIMOTO		

005514
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NEW YORK NY 10112-3801

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HARTAR EXAMINER

ART UNIT

PAPER NUMBER

01/04/99

27

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/811,234

Applicant(s)
Sugimoto

Examiner
Joseph W. Hartary

Group Art Unit
2853



☒ Responsive to communication(s) filed on Oct 27, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 4-14, 17-22, 25-30, and 33-62 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 4-14, 17-22, 25-30, and 33-62 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4-14, 17-22, 25-30 and 33-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims call for the plurality of inks to contain different component ratios of a surface active component, wherein an ink having a relatively high dye density has a lower component ratio of said surface active component than an ink having a relatively low dye density. The written description of this feature in the specification is considered inadequate. Regarding Claim 36, the specification does not provide evidence that the plurality of adhering inks have the same claimed properties, that is, that the solidified inks adhering to the recording medium have the same properties as the liquid inks in the recording head.

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3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 36 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim calls for a recorded article comprising a recording medium and a plurality of inks adhering thereto, the inks having different dye densities, different penetrabilities, and different component ratios of a surface active component. Such a recorded article is considered printed matter. MPEP 706.03(a).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto 4,860,026 in view of Suzuki 4,551,736 and Sugimoto 5,477,248. Matsumoto discloses a recorded article

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comprising a recording medium 51 and a plurality of inks adhering thereto. Each of the inks would have a dye density, color, a penetrability, and a surface active component ratio. The inks have different dye densities and the same color. The claims differ from Matsumoto by reciting inks have different dye densities and the same colors have different penetrabilities. The claims further recite the ink having a relatively high dye density has a lower component ratio of surface active component than an ink having a relatively low dye density. The claimed recorded article is considered prima facie obvious over the Matsumoto recorded article 51 because a recording medium with a plurality of inks adhering thereto is shown. Penetrabilities and surface active components are considered ink expedients as evidenced by Suzuki and Sugimoto.

7. Claims 37-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto 4,860,026 in view of Suzuki 4,551,736, Sugimoto 5,477,248 and Sekiya JP 1-242256. Matsumoto discloses (figure 9) an ink jet apparatus having plural ink discharge means 58-1 to 58-10 using a plurality of inks. It would have been obvious to further modify the inks with different penetrabilities as evidenced to be known by Suzuki and Sugimoto for the reasons given by Suzuki and Sugimoto. The claims

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further recite the plural inks are divided and held in the same container. Sekiya teaches plural inks held in a divided container are known. It would have been further obvious to modify the Matsumoto ink jet apparatus with a divided container, a feature suggested by Sekiya, for the purpose of containing the inks in a known alternative manner. The features recited in the dependent claims are suggested by the cited references.

8. Applicant's arguments filed October 27, 1998 have been fully considered but they are not persuasive. Applicants submit that the feature relating to different component ratios of a surface active component is supported at least by original claims 3,16,24 and 32. This argument is not persuasive. Original claims may be support for a feature but they are not written description in the specification. It is argued that the penetrabilities are positively differentiated in order to improve the qualities of the image in accordance with the ink densities. This argument is not persuasive. Improvement of the image quality in accordance with the image densities is not a claimed feature. In addition, no support has been pointed out for such a feature.

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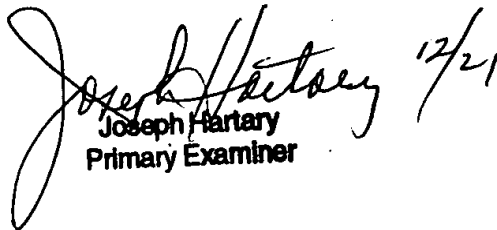
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Hartary whose telephone number is (703) 308-3124.

JH

December 21, 1998

 12/21
Joseph Hartary
Primary Examiner